

REMARKS

APPLICATION STATUS

No claims have been canceled and no new claims have been added. Accordingly, claims 1-20 are pending in the present application. No new matter has been introduced by way of the present amendment.

DRAWINGS

The Office Action fails to indicate whether the drawings are accepted by the Examiner. Such an indication is respectfully requested.

35 USC § 112 REJECTION

The rejection of claims 8, 10, and 20 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention, is noted. Claims 8, 10, and 20 have been amended to overcome the rejection.

35 USC § 102 REJECTIONS

Claims 1-9 are allowable over US 5,476,142 to Sparlin et al.

The rejection of claims 1-9 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,476,143 to Sparlin *et al.* (hereinafter referred to as "the Sparlin patent") is respectfully traversed for the reasons set forth hereinafter.

Claim 1 recites:

a base pipe having a sidewall with at least one hole through the sidewall;
a filter surrounding at least a portion of the base pipe;
a plurality of splines located between the base pipe and the filter; and

a rod selectively insertable between adjacent splines to selectively cover the at least one hole. [Emphasis added]

The Office Action alleges that the perforation 2a and the support rod 3 of the Sparlin patent are the presently claimed at least one hole and rod, respectively. Applicants respectfully traverse this allegation as being contrary to fact. The Sparlin patent discloses that the "support rods 3 are disposed in a position where they do not interfere with the perforations 2a of the pipe 2."¹ Thus, the Sparlin patent does not disclose or suggest a rod selectively insertable between adjacent splines to selectively cover the at least one hole, as required by claim 1. Rather, the Sparlin patent teaches that the rods 3 do not cover the perforations 2a.

Claim 1 is anticipated by the Sparlin patent, "[o]nly if each and every element as set forth in the claim is found, either expressly or inherently described" in a single prior art reference."² Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim."³ The Sparlin patent, however, falls short of these requirements.

As indicated above, the Sparlin patent teaches away from the claimed limitation of a rod selectively insertable between adjacent splines to selectively cover the at least one hole. Accordingly, the Sparlin patent cannot render the present invention, as set forth in claim 1, obvious.

Claims 2-9 depend from claim 1. Accordingly, the remarks provided above apply equally to claims 2-9.

Therefore, it is respectfully requested that the rejection of claims 1-9 under 35 USC § 102(b), as being anticipated by the Sparlin patent, be reconsidered and withdrawn.

¹ See column 4, lines 50-51, of the Sparlin patent.

² See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

³ See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 10-16 and 18-20 are allowable over US 5,394,938 to Cornette *et al.*

The rejection of claims 10-16 under 35 USC § 102(b), as being anticipated by U.S. Patent No. 5,394,938 to Cornette *et al.* (hereinafter referred to as "the Cornette patent"), is respectfully traversed for the reasons set forth hereinafter.

Claim 10, as amended to overcome the 35 USC § 112 rejection, recites:

a base pipe having a central cavity enclosed by a sidewall, the sidewall having a plurality of holes therethrough; and

a sleeve circumferentially adjacent and rotatably attached to the base pipe, the sleeve having at least one opening therethrough, and wherein rotation of the sleeve relative to the base pipe aligns or misaligns the holes and the at least one opening openings to vary the fluid communication between the well bore and the central cavity. [Emphasis added]

The Office Action alleges that the base pipe 40 and the screen jacket 41 of the Cornette patent are the claimed base pipe and sleeve, respectively. The Cornette patent, however, fails to disclose or suggest that the screen jacket 41 can be rotated to vary the fluid communication *first* between the well bore and the central cavity, as required by claim 10. The Cornette patent illustrates the openings through the base pipe 40 to be generally the same size and regularly spaced and the openings through the screen jacket 41 to be generally the same size and regularly spaced.⁴ Accordingly, Applicants maintain that rotating the screen sleeve 41 with respect to the base pipe 40 would not vary the fluid communication between the well bore and the central cavity, as required by claim 10.

It should be noted that the screen jacket 41 is allowed to rotate with respect to the base pipe ⁴⁰ ~~41~~ so that it will not be subjected to any substantial torques as the workstring 18 is rotated to lower the gravel pack liner 21 into the gravel 14, or to inhibit such torques when the workstring 18 is rotated in a reverse direction to dislodge the gravel pack screen 21 from the

⁴ See Figure 2 of the Cornette patent.

gravel 14.⁵ The Cornette patent fails to disclose or suggest rotating the screen jacket 41 with respect to the base pipe 40 to vary fluid communications therethrough. Accordingly, the present invention, as set forth in claim 10, is allowable over the Cornette patent.

Claims 11-16 and 18-20 depend from claim 10. Therefore, the remarks provided above concerning claim 10 apply equally to claims 11-16 and 18-20.

Accordingly, it is respectfully requested that the rejection of claims 10-16 under 35 USC § 102(b), as being anticipated by the Cornette patent, be reconsidered and withdrawn.

35 USC § 103 REJECTION

Claim 17 is allowable over US 5,394,938 to Cornette *et al.* in view of US 6,457,518 to Castano-Mears *et al.*

The rejection of claim 17 under 35 USC § 103(a), as being unpatentable over the Cornette patent in view of U.S. Patent No. 6,457,518 to Castano-Mears *et al.* (hereinafter referred to as "the Castano-Mears patent"), is respectfully traversed for the reasons set forth hereinafter.

Claim 17, which depends from claim 10, requires a sleeve circumferentially adjacent and rotatably attached to the base pipe, the sleeve having at least one opening therethrough, and wherein rotation of the sleeve relative to the base pipe aligns or misaligns the holes and the at least one opening openings to vary the fluid communication between the well bore and the central cavity. As discussed above, the Cornette patent fails to disclose or suggest rotating the screen jacket 41 with respect to the base pipe 40 to vary fluid communications therethrough. Further, the Castano-Mears patent also fails to disclose or suggest such a configuration. The Castano-Mears patent teaches an expandable well screen 14 but is silent with regard to the screen

⁵ See column 5, lines 37-49, of the Cornette patent.

14 being rotatably attached to another member. To establish a *prima facie* case of obviousness, three basic criteria must be met⁶:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, rather than merely in Applicants' disclosure, to modify the reference or to combine reference teachings;
- (2) There must be a reasonable expectation for success found in the prior art, rather than in Applicants' disclosure; and
- (3) The prior art references must teach or suggest all the claim limitations.

The Cornette patent, either taken singly or in combination with the Castano-Mears patent, falls short of these requirements.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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⁶ See MPEP 2143 and *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).